

Xerox Docket No. 99632-US-NP

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

Alex TAYLOR et al.

On Appeal from Group: 2176

Application No.: 09/981,835

Examiner: L. RIES

Filed: October 19, 2001

Docket No.: 110914

For: METHOD AND APPARATUS FOR FORWARD ANNOTATING DOCUMENTS

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
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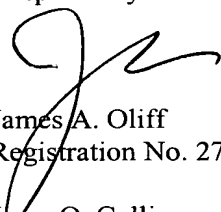
Sir:

Attached hereto is our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of Five Hundred Dollars (\$500.00) in payment of the Brief fee under 37 C.F.R. 41.20((b)(2). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,


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BRIEF ON APPEAL

Appeal from Group 2176

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal and the present application is Xerox Corporation, by way of an Assignment recorded in the U.S. Patent and Trademark Office beginning at Reel 012275, Frame 0280.

II. STATEMENT OF RELATED APPEALS AND INTERFERENCES

There are no prior or pending appeals, interferences or judicial proceedings, known to Appellants, Appellants' representative, or the Assignee, that may be related to, or which will directly affect or be directly affected by or have a bearing upon the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-7, 9-16, 18, and 19 are on appeal.

Claims 1-7, 9-16, 18, and 19 are pending.

No claims are allowed.

Claims 1-7, 9-16, 18, and 19 are rejected.

Claims 8 and 17 have been canceled.

IV. STATUS OF AMENDMENTS

A Request for Reconsideration was filed on March 3, 2006 in reply to the Final Rejection mailed February 11, 2006. The Request for Reconsideration was considered by the Examiner, as evidenced by the Advisory Action mailed March 17, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claims relate to systems and methods for processing documents stored in a database, the documents including a source document and a target document. The systems and methods store a plurality of words, each of the plurality of words stored as a result of being annotated in the source document. The systems and methods identify whether any of the words present in the storage device are present in the target document and annotate the words located in the target document in the same manner that they were annotated in the source document. Importantly, the source document and the target document are pre-selected from the database as the source document and the target document by a user of the system before the source document is annotated. Fig. 1 generally illustrates an exemplary system encompassed by claims 1-7. Figs. 4 and 5 generally illustrate exemplary methods encompassed by claims 9-16, 18, and 19, which may be implemented, for example, by a system similar to that of Fig. 1.

In particular, for example, referring to Fig. 2, the function of the claimed systems and methods is to automatically annotate a target document 25 which a user may desire to read, to indicate regions of interest based on previously stored annotations from a source document(s) 26 (P3/L10-13). The system and methods produce an annotated target document 27 that is based on external annotations previously made by the user (or other users) to the source document 26 (P3/L13-15). In this manner a user does not have to read several documents (i.e., the source document and the one or more known target documents), looking for the same information in each document (P1/L14-15). Reading each document separately is very time consuming and the user may be likely to miss or overlook important information buried in other text (P1/L15-17). Thus, the known target documents are marked with the same annotations automatically (P1/18-19 and 26-28).

One example is illustrated in Fig. 3. Fig. 3 (c) shows a source document 30, which has been annotated on paper by a user to represent the useful text 32 which the user wishes to identify in future target documents (P3/L17-19). The document 30, for example, may then be scanned into the processing system 10, which processes the scanned image to identify the annotated text (P3/L20-23).

Fig. 3 (a) illustrates a known target paper document 34 which the user now wishes to read (P3/L23-24). At this stage the target document is plain (i.e., it contains no annotations to guide the user to the significant text) (P3/L24-25). Thus, the target document 34 may be scanned into a processing system, which then processes the scanned image to identify whether any of the previously annotated words 32 are present in the target document (P3/L25-28). If previously annotated words 32 are present, then the same words appearing in the target document 34 are annotated (for example, within the digital image 35 of the target document 34) to be given the same annotations 36 as the source document 30, as illustrated in Fig. 3 (b) (P3/L28-31). The annotated target document can then be displayed or printed out for the user to read with the same annotations made on the source document (P3/L31-32); thereby preventing the user from spending additional time manually annotating the target document with the possibility of missing or overlooking important information.

Although, in the above example, the source document and target document are originally paper documents, they may also be originally electronic (P4/L7-13).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are presented for review:

1) Claims 1-7, 9-16, 18, and 19 remain rejected under 35 U.S.C. §103(a) over Price et al., *Linking by Inking: Trailblazing in a Paper-Like Hypertext* (hereinafter "Price") in view of Golovchinski et al., *From Reading to Retrieval: Freeform Ink Annotations as Queries* (hereinafter "Golovchinski") and further in view of Lawton et al., *The Knowledge Weasel Hypermedia Annotation System* (hereinafter "Lawton").

VII. ARGUMENT

The Final Rejection fails to establish a *prima facie* case of obviousness with respect to the outstanding rejections of pending claims 1-7, 9-16, 18, and 19. In particular, the Final Rejection fails to provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings.

A. Requirements for a prima facie case of obviousness under 35 U.S.C. §103(a)

In order to establish a *prima facie* case of obviousness, three criteria must be met (MPEP §§ 2142, 2143). 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. 2) There must be a reasonable expectation of success. 3) The prior art reference (or references when combined) must teach or suggest all of the claim limitations. The first two criteria must both be found in the prior art, and not based on Applicants' disclosure.

B. The Final Rejection fails to provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings.

Applicants respectfully submit that the Final Rejection fails to satisfy at least the first criteria for a *prima facie* case of obviousness. Specifically, according to MPEP §2143.01(V) and MPEP §2143.01(VI), the Final Rejection has failed to provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify the reference or combine reference teachings. MPEP §2143.01(V) states that if the proposed modification of a reference would render the invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. MPEP §2143.01(VI) states that if the proposed modification of combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.

The Final Rejection suggests that it would have been obvious to the skilled artisan to modify the system and method of Price by the alleged teachings of Golovchinski and Lawton

to arrive at the claimed invention. However, Applicants respectfully submit that such a modification of the system and method of Price would render the system and method of Price unsuitable for their intended purpose as well as change their principle of operation.

In particular, Price discloses a system and method whereby a user may annotate a document (P32/C2-P33/C1). Based on the annotations, the system and method create a query (P34/C2-P35-C1). The query, created by the annotation, is then used to search a database of documents (P36/C1). Documents returned by the search ("target documents" in the context of Price) and related to the annotations are presented to the user, for example, as links in the margin of the document or at the end of the document (P33/C1-P34/C2). The annotated words may be underlined in the returned documents (P34/C1-C2).

Importantly, because the device and method of Price both create a query based on the user's annotation and use the query to search for target documents, the system and method of Price locate new and unknown target documents from the database based on the search after the annotations. Thus, the target documents of Price are unknown at the time of annotation. This is done in Price based on the primary operating principle of Price that the returned new and unknown documents will be useful to the user by providing additional new and unknown information to the user (P33/C2-34/C2)¹.

The Final Rejection alleges that Lawton teaches the pre-selection of "target documents." However, were Price modified by the Final Rejection's alleged teaching of Lawton to pre-select target documents before the source document is annotated, then both the query creation function and subsequent document search function of Price would be unnecessary. That is, there would be no reason to create a query for a search, as the target documents would already be known. Similarly, there would be no reason to search for documents based on the query if the target document is already pre-selected and known to the system. Importantly, if the system and method of Price were modified as suggested by the Final Rejection such that the target document was pre-selected, the system and method of

¹ "Serendipity is a common and rewarding experience when browsing in libraries. People looking for a particular book on the shelf often find unintended yet valuable material nearby" (P33/C2, emphasis added). "Xlibris margin links provide this kind of serendipity to readers as they read" (P33/C2).

Price would be incapable of providing a user with "unintended yet valuable" documents (P33/C2). Thus, Price would be rendered unsuitable for its intended purpose.

Furthermore, the Final Rejection's alleged modification of the system and method of Price would change the principle of operation of Price. As evident from Price's discussion of Serendipity on page 33, column 2, (reproduced in part in note 1, *supra*) and Price's discussion of endnotes on page 34, columns 1 and 2, the principle of operation of the systems and methods of Price is to provide a user with new and unknown documents while a user reads and annotates a known document. To modify Price as suggested by the Final Rejection to only provide the user with known pre-selected documents would be directly contrary to this principle of operation.

Because, the modification of Price suggested by the Final Rejection would render the system and method of Price unsuitable for its intended purpose and/or the Final Rejection's alleged modification of the system and method of Price would change the principle of operation of Price, there can be no motivation for such a modification (MPEP §§ 2143.01(V) and 2143.01(VI)). Because there is no motivation to modify Price as suggested by the Final Rejection, the Final Rejection has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection is improper. Applicants respectfully request withdrawal of the rejection.

In response to the above arguments, the March 17, 2006 Advisory Action alleges that the Final Rejection's proposed modification of Price would not render the invention of Price unsuitable for its intended purpose because "there is no reason to omit the possibility that the data source from which these documents are selected is a finite collection of documents." However, this allegation does not remedy the above-described deficiencies of the §103(a) rejection for at least the following reasons.

First, assuming that the Advisory Action is using the phrase "finite collection of documents" to mean a collection of target documents, each of which will be annotated, the deficiencies of the §103(a) rejection are not remedied. In this case, the target documents would be known to the user. Thus, as discussed above, there would be no reason to create a query for a search, as the target documents would already be known and would not need to be

searched for. Similarly, there would be no reason to search for documents based on the query if the target document is already pre-selected and known to the system. Thus, the modification of Price suggested by the Final Rejection would render the system and method of Price unsuitable for its intended purpose and/or the Final Rejection's alleged modification of the system and method of Price would change the principle of operation of Price.

Second, assuming the Advisory action is using the phrase "finite collection of documents" to mean a collection of documents from which the target documents are subsequently selected, the deficiencies of the §103(a) rejection are not remedied. In this case, although the collection of documents (i.e., the database) that will be searched by the modified system and method of Price may be known, the actual target documents which would be returned as a result of the search would not be known. That is the target documents would not be "pre-selected from the database as the...target document by a user of the system before the source document is annotated," as recited by pending claims 1 and 9, and similarly required by claim 19. This is because, according to Price, the target documents would only be selected as a result of the search, which occurs as a result of and after the annotation of the source document.

C. Conclusion

Because there is no motivation to modify Price as suggested by the Final Rejection, the Final Rejection has failed to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a). Accordingly, the rejection of claims 1-7, 9-16, 18, and 19 under 35 U.S.C. §103(a) over Price in view of Golovchinski and further in view of Lawton is improper.

VIII. CONCLUSION

For at least the reasons discussed above, it is respectfully submitted that the rejections are in error and that claims 1-7, 9-16, 18, and 19 are in condition for allowance. For at least the above reasons, Appellants respectfully request this Honorable Board to reverse the rejections of claims 1-7, 9-16, 18, and 19.

Respectfully submitted,



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APPENDIX A - CLAIMS APPENDIX

CLAIMS INVOLVED IN THE APPEAL:

1. A system for processing documents stored in a database, the documents including a source document and a target document, the system comprising:
 - a storage device for storing a plurality of words, each of the plurality of words stored as a result of being annotated in the source document;
 - a search device for identifying whether any of the words present in the storage device are present in the target document; and
 - an annotation device for annotating said words located in the target document in the same manner that they were annotated in the source document;
 - wherein the source document and the target document are pre-selected from the database as the source document and the target document by a user of the system before the source document is annotated.
2. A system according to claim 1, further comprising an input device for inputting words from the source document into the storage device, the input device comprising:
 - a detector for detecting one or more annotated regions in the source document;
 - and
 - a device for entering one or more words from a detected annotated region of the source document into the storage device.
3. A system according to claim 2, wherein the source document is a physical document and the input device further comprises a capture device for capturing a digital image of the source document.
4. A system according to claim 3, wherein the detector is operable to detect annotations in the captured image of the source document.

5. A system according to claim 4, wherein the detector is operable to detect a type of annotation.

6. A system according to claim 5, wherein the type of annotation comprises at least one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring.

7. A system according to claim 1, wherein the target document is a physical document, the system further comprising a capture device for capturing a digital image of the physical target document to be annotated.

8. (Canceled)

9. An at least one device implemented method of processing documents stored in a database, the documents including a source document and a target document, the method comprising:

storing a plurality of words of interest, each of the plurality of words of interest stored as a result of being annotated in the source document;

searching the target document to identify whether any of said words of interest are present in the target document; and

annotating said words located in the target document in the same manner that they were annotated in the source document;

wherein the source document and the target document are pre-selected from the database as the source document and the target document by a user of the at least one device before the source document is annotated.

10. A method according to claim 9, further comprising inputting words from the source document into the stored words of interest.

11. A method according to claim 10, further comprising detecting one or more annotated regions in the source document, and entering one or more words from a detected annotated region of the source document into the stored words of interest.

12. A method according to claim 10, wherein the source document is a physical document, the method further comprising optically capturing a digital image of the source document.

13. A method according to claim 11, wherein said detecting comprises detecting annotations in a captured image of the source document.

14. A method according claim to 13, wherein said detecting comprises detecting a type of annotation.

15. A method according to claim 14, wherein the type of annotation detected comprises one of highlighting, underlining, circling, crossing through, bracketing, bolding, italicizing, and coloring.

16. A method according to claim 9, wherein the target documents is a physical document, the method further comprising optically capturing a digital image of the physical target document to be annotated.

17. (Canceled)

18. The method according to claim 9, wherein the method is implemented by a set of program instructions stored in a storage medium and executable on a data processing device.

19. An at least one device implemented method of processing at least two documents, comprising:

inputting a source document, the source document pre-selected as the source document by a user of the at least one device;

inputting a target document, the target document pre-selected as the target document by a user of the at least one device;

annotating, after the pre-selection of the source document and the target document, the source document to identify a plurality of words of interest;

storing the plurality of words of interest;

searching the target document to identify whether any of the plurality words of interest are present in the target document; and

annotating the identified words of interest located in the target document;

wherein a same annotation is used for a same word of interest in the source document and the target document.



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APPENDIX B - EVIDENCE APPENDIX

NONE

APPENDIX C - RELATED PROCEEDINGS APPENDIX

NONE